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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/487,239 | 01/20/2000 | Norikane Nabata | Q57646 | 2929 |

7590

07/08/2002

Sughrue Mion Macpeak & Seas PLLC
2100 Pennsylvania Avenue N W
Washington, DC 20037

EXAMINER

VO, HAI

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1771

9

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-9

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 09/487,239 | Applicant(s) NABATA ET AL. | |
| | Examiner Hai Vo | Art Unit 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 and 8-11 is/are allowed.
- 6) ☒ Claim(s) 2-5 and 7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

1. Claim 1 has been cancelled in the amendment received on 05/08/2002.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al (US 5,772,884) in view of Herding et al (US 5,547,481). Tanaka discloses a laminate comprising a porous PTFE film and a porous polyethylene as the porous reinforcing polyethylene coated on either one or both sides of the porous PTFE film (column 4, line 34-55). Tanaka does not specifically disclose the porous reinforcing material formed from Ultra High Polyethylene (UHPE). Herding teaches a filter element comprising a porous shaped body made substantially of UHPE that forms a binding skeleton between the grains of UHPE (column 7, lines 1-5 and figure 4). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a porous UHPE with the grain shape as taught by Herding as the porous reinforcing material for the laminate of Tanaka motivated by the desire to obtain a laminate which is useful as a filter.
4. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al (US 5,772,884) in view of Herding et al (US 5,547,481) as applied to

claim 3 above, further in view of Dauber et al (US 5,916,671). The combination of the primary and secondary references fails to suggest the filter that is made of the laminate and holds an adsorbent. Dauber discloses a gasket comprising a layer of a porous PTFE film and a stiffening layer of polyethylene (abstract and column 8, lines 10-15). Dauber discloses a gasket having three dimensions (length, width and height) shown in example 8 holding adsorbent particles (column 7, lines 42-50). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a filter that is made of the laminate and holds an adsorbent as taught in Dauber motivated by the desire to enhance the performance of the filter

With regard to claims 7, Dauber is silent as to the shape of the laminate. *In re Dailey*, 149 USPQ 47 (CCPA 1976), there is no evidence in the specification of the present invention that convinces the examiner that the particular shape of the laminate is significant or is anything more than one of numerous shapes a person of ordinary skill in the art would find obvious for the purpose of providing the shape of the laminate, therefore, the shape of the laminate in itself would not render the claims patentable over Tanaka as modified by Herding and Dauber. See *Graham v. John Deere Co.*

Allowable Subject Matter

5. Claims 6, and 8-11 are allowed. The reasons for allowance have been given in the Paper no. 6.

Response to Arguments

6. Applicant's arguments with respect to claims 2-5 and 7 have been considered but are moot in view of the new ground(s) of rejection.

The art rejections in Paper no. 6 have been overcome by the present response.

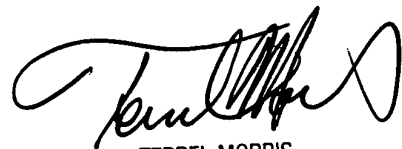
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
June 28, 2002



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700